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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/505632
Filing Date: 4/19/01
Appellant(s): Scroggie, et al.

Carlos R. Villamar
For Appellant

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EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 4/19/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 28 and 40 stand or fall together, claims 30 and 46 stand or fall together, claims 24, 36 and 48 stand or fall together, claim 49 stands alone, claims 25 and 37 stand or fall together, claims 27 and 39 stand or fall together, claims 29 and 41 stand or fall together, claims 26 and 38 stand or fall together, claims 30 and 42 stand or fall together, and claims 31 and 43 stand or fall together

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,918,211	Sloane	6-1999
6,012,039	Hoffman, et al.	1-2000
5,915,243	Smolen	6-1999

(10) *Grounds of Rejection*

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 28, 34, 40, 46, are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 34, 40, 46, Sloane discloses:

transmitting from a consumer computer.../means for transmitting from a consumer computer...(Col. 7, lines 5-10);

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in response to receipt of said request at said Web site of said retailer.../means for, in response to receipt of said request at said Web site of said retailer (Col. 7, lines 13-22);

in response to receipt of said request at said remote site.../means for, in response to receipt of said request at said remote site...(Col. 7, lines 22-26);

in response to receipt of said manufacturers incentives.../means for, in response to receipt of said manufacturers incentives...(Col. 8, lines 3-7).

updating a manufacturers incentives database.../means for updating...(Col. 7, lines 36-40).

The following is inherent with Sloane's invention because Sloane does disclose that the communication line of his invention can be an online computer network or the Internet (See col. 7, lines 18-22) and it is traditional practice to present data using a graphical user interface which presents graphical image data:

including graphical image data corresponding to said manufacturers incentives...

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 24-25, 27, 29, 36, 37, 39, 41, 48, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039).

As per claim 24, 36, 48, 49, Sloane discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request.../means for transmitting...in response to said request for manufacturer incentives, transmitting region data...means for, in response to said request...in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data...(Col. 7, lines 5-26);

Sloane fails to teach the following, however Hoffman, et al discloses:

transmitting...at least one name.../means for transmitting...at least one name...(Col. 11, lines 1-9 read with Col. 13, lines 5-10);

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following, however Hoffman, et al discloses:

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wherein said step of transmitting from said remote site said list further comprises transmitting a link.../wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 14, lines 64-67).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.

As per claim 27, 39, Sloane discloses:

transmitting from said consumer computer.../means for transmitting...(Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

Sloane fails to disclose the following, however Hoffman, et al discloses:

transmitting from said Web site of said manufacturer.../means for transmitting from said Web site...(Col. 6, line 46);

transmitting from said remote site to said Web site of said manufacturer details.../means for transmitting from said remote site...(Col. 6, lines 57-58);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer...(Col. 6, lines 62-63).

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hoffman, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane discloses:

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transmitting a user identification.../means for transmitting a user identification...determining manufacturer's incentives.../means for determining manufacturer's incentives...(Col. 9, lines 52-58, Claim 12, Claim 15).

5. Claims 26, 30, 31, 38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039) and Smolen (US Patent 5,915,243).

As per claims 26, 30, 38, 42, both Sloane and Hoffman, et al fail to disclose the following, however Smolen. discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining...transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting...(Col. 2, line 66-Col. 3, line 9).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claims 31, 43, both Sloane and Hoffman, et al fail to teach the following, however Smolen discloses:

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wherein said region data is postal code data...(Col. 4, lines 64-67, where the examiner feels that the area code is analogous to the postal code).

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer.

(11) Response to Argument

As per the rejection of claims 24-31, 34, 36-43, 46, 48 and 49, the rejections are maintained due to appellant's unpersuasive argument as set forth in section VII of this action.

As per claims 28 and 40, appellant argues that Sloane fails to disclose distribution product incentives to consumers over the Internet. However the examiner disagrees. Sloane discloses this feature in Col. 7, lines 4-26. Here, Sloane clearly discloses that consumers are provided with discount and other promotional information where the communication line can be the Internet. Appellant also argues that the structure of the network in Sloane is different from the structure of the network of the present invention because according to appellant, in response to the receipt of the request at the Web site of the retailer, the request is transmitted from the Web site of the retailer over the Internet to a remote site and then transmitting from the remote site a list of manufacturer incentives to the Web site of the retailer and from the Web site of the retailer to the consumer. However, Sloane shows discloses this feature. In Fig. 3b, Sloane shows that the retailer computer receives promotional information from a third party sender which the examiner is interpreting as the remote Web site of the present

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invention. The promotional information is then sent to the consumer from the retailer computer as shown in Col. 7, lines 22-40 (Specifically Col 7, lines 22-26).

As per claims 34 and 36, appellant argues that Sloane fails to disclose updating a manufacturers incentives database for storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data and argues that although it may be traditional practice to present data using a graphical user interface, which presents graphical image data over the Internet, according to appellant, this does not mean that data defining manufacturers incentives including graphical image data corresponding to manufacturer's incentives is stored. However, the examiner disagrees. In Col. 7, lines 13-26, Sloane discloses that the sender of promotional information can send the information via the Internet to the retailer computer which stores the promotional information. In Col. 7, lines 36-38, Sloane also teaches the 'updating' limitation of the data storage means. Sloane does not specifically disclose graphical image data, however, it is obvious to use graphical image data to present data to computers on a Internet based network.

As per claims 24, 36 and 48, appellant argues that Hoffman, et al fails to cure the following deficiencies with Sloane: "in response to receipt of region data at the manufacturer's Web site, transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and the at least one name and address." Appellant argues that in Hoffman, et al, there is no need to send a name and address of a retailer since Hoffman, et al

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teaches that the identification of both parties during an incentives distribution transaction are automatically identified by decrypting provided encryption codes. However, the examiner disagrees with this argument. First, in Hoffman, et al, the Issuer ID which consists of the manufacturer name (trade name, Col. 13, lines 5-10), and the instructions for the credit and debit of a recipient's reward account is transmitted along with the transaction request message (Col. 11, lines 5-12). Once the rewards account is located, the reward-units are credited/debited to/from the rewards account. This shows that Hoffman, et al at least identifies the name and address of the manufacturer. In addition, Hoffman, et al discloses that a rewards issuer digital certificate which is transmitted to the recipient (the consumer) as an incentive contains readable text and other information identifying the manufacturer such as the corporate logo, address and company name (See, Col. 13, lines 11-18).

As per claim 49, appellant argues that this claim recites substantially the same features as claims 28 and 40 and is patentably distinguishable over Sloane for substantially the same reasons as discussed with respect to claims 28 and 40. In addition, appellant also argues that Hoffman, et al fails to cure the deficiencies of Sloane. However, the examiner disagrees with this argument and claim 49 is still rejected for the same reasons as discussed above with respect to claims 28 and 40.

As per claims 25 and 37, the appellant argues that the combination of Sloane and Hoffman, et al fails to teach the step of transmitting a link to a Web site of the retailer. However, the examiner disagrees. In combination with Sloane, this limitation is met because

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Sloane teaches that a remote third party sender transmits promotion information to the retailer computer and then to the consumer computer. Since Hoffman, et al teaches that the issuer identity (issuer address, name) can be transmitted to a consumer with the reward as described above, it is only obvious that a recipient would use a the network address (link) of the rewards issuer to pull up the issuer site as done in Col. 14, lines 64-67).

As per claims 27 and 39, the appellant argues that Sloane fails to disclose transmitting form a consumer computer to a Web site of a manufacturer selection data indicating selection of at least one manufacturer incentive. However, the examiner disagrees. Sloane discloses this "selection" limitation in Col. 6, lines 2-4. In addition, appellant argues that neither Sloane or Hoffman, et al teaches the following: transmitting from a Web site of the manufacturer to a remote site selection data; transmitting from the remote site to the Web site of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to a consumer computer the details. However, the examiner disagrees. The examiner feels that Sloane discloses "transmitting from a Web site of the manufacturer to a remote site selection data" in Col. 7, line 65-Col. 8, line 4 where the sender is receiving selection data received from the scanner. The examiner feels that the combination of Sloane and Hoffman, et al discloses " transmitting from the remote site to the Web site of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to a consumer computer the details" since Sloane teaches that promotion information is sent form a third party sender to a retailer to a

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consumer, and since Hoffman, et al discloses that information is displayed about the reward/promotion which allow parties to approve or cancel a reward transaction (Col. 6, lines 57-58, examiner is interpreting this to be detailed information), the examiner believes that these limitations are met.

As per claims 29 and 41, the appellant argues that neither Sloane or Hoffman, et al disclose transmitting a user identification from a Web site of a retailer over the Internet to a remote Web site in association with a request and determining manufacturer's incentives to transmit for the remote Web site to the Web site of the retailer base upon the user identification. However, the examiner disagrees. Sloane discloses this limitation (See claim 12, claim 15, claims 20-22 and Col. 7, line 65-Col. 8, line 7). Here, Sloane discloses that consumer identification consisting of the consumer's identity and purchasing history are received by the scanner and once the purchase history is accessed through the scanner, the purchase history is compared to the promotional information and available promotions through this comparison are transmitted. In addition Sloane also discloses that Communication line can be a direct modem connection between two computers or an on-line network or even the Internet (Col. 7, lines 15-22) and also discloses a third party sender (Fig. 3b).

As per claims 26, 30, 31, 38, 42 and 43, the appellant argues that Hoffman, et al is not prior art with respect to appellants June 12, 1997 priority date. However, the Hoffman, et al patent is a continuation of application No. 08/705399 now patent No. 5,780,723 filed

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August 29, 1996. Therefore, the Hoffman, et al patent can claim priority to this date which is before the priority date of the present application and can therefore be used as prior art.

As per claims 26, and 38, the appellant argues that the Smolen reference fails to teach the following deficiency: "determining at least one manufacturer's incentive and at least one name and address of a retailer by querying, using region data, a database 16 for a server 14 of a remote Web site." The examiner disagrees. The combination of Sloane and Hoffman, et al discloses determining at least one manufacturer's incentive and at least one name and address as described above with respect to claims 24, 36 and 48. In addition, the Smolen reference was added to show the "querying" feature. This feature is described in Smolen in Col. 3, lines 1-7 specifically where it discloses "Each information profile contains demographic information that is used for targeting promotions and coupons by filtering the information for selected marketing criteria. The information profile is used to determine which promotions may be of interest to the person..."

As per claims 30 and 42, the appellant argues that the Smolen reference fails to teach the following deficiency: "transmitting from a consumer computer over the Internet to a Web site 12 of a retailer region data." However, the examiner disagrees. As described above with reference to claims 29 and 41, the combination of Sloane and Hoffman, et al discloses the transmission of data from a consumer computer over the Internet to a Web site of a retailer. The Smolen reference was added to show that this data could be region data (See Col. 2,

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line 66-Col. 3, line 7, [examiner is interpreting the region data of the present invention to be the demographic information of a household of Smolen]).

As per claims 31 and 43, the appellant argues that the combinations of Sloane, Hoffman, et al and Smolen fail to teach that the region data is postal code data. However, the examiner disagrees because Smolen discloses that the area-code and exchange can be a demographic addition to an information profile for a household. As described above in the preceding paragraph, the examiner is interpreting the region data of the present invention to be the demographic information of a household of Smolen and area-code/exchange data is analogous to postal code data because it is common in places like the phone company to use someone's area-code and at least the first three numbers of an exchange to retrieve address and postal code data.

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For the above reasons, it is believed that the rejections should be sustained.

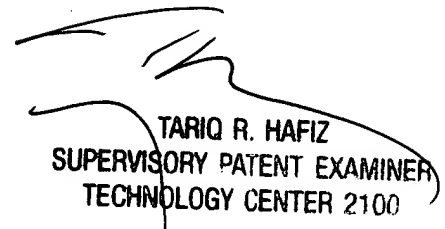
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